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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,462	03/30/2004	Richard F. Stockel		4677

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EXAMINER
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KOSLOW, CAROL M

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/813,462

Applicant(s)

STOCKEL ET AL.

Examiner

C. Melissa Koslow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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This action is in response to applicants' amendment of 19 July 2005. The amendment to the specification has overcome the objections to the disclosure and the specification and the 35 USC 112 written description rejection over claims 4, 6, 7, 12, 15 and 20-22. The amendment to the claims have overcome the objections to the claims, the 25 USC 112, enabling rejection over claim 1 and 3-5, the 35 USC 112, second paragraph rejection with respect to missing essential elements over claims 1 and 3-5, the rejections over claim 2, and the rejection over claim 6 with respect to the pH. Applicant's arguments with respect to the remaining rejections have been fully considered but they are not persuasive.

The amendment filed 19 July 2005 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The change in HLB values from "about 2 to about 10" to "about 2 to about 12". The insertion after line 9 on page 4. The sentence starting in line 4 of the insertion after line 5 on page 5. The change in the amount of inorganic and/or organic salt from "0.2 to 2.5" to "0.2 to 5.0". The change of the amount of buffering salt from "0.1 to 1.5" to "0.3 to 4.0". The insertion at the end of paragraph one in line 4 on page 8.

Applicant is required to cancel the new matter in the reply to this Office Action.

There is no explanation as to the sources of these amendments in the original disclosure, nor is there any explanation as to why the amendments to the amounts of salts and the HLB range were made.

Claims 6, 7, 12 and 19 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably

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convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 6, the change in the upper limit of the HLB range is new matter. The insertion in claim 7 that the chelating agent and the desensitizing polymer are optional is new matter. The newly claimed amount in claim 12 of buffering system is new matter. The amount of acid-salt buffering system in claim 19 is different from that in the specification. This claim teaches the amount is about 5-10 wt% and the specification teaches the amount of buffering acid is 0.3-4 wt% and the amount of buffering salt is 0.2-5 wt%.

The amendment to the claims did not correct the remaining rejection to claim 19.

Claims 6, 7, 9 and 11-22 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Subject matter that is critical or essential to the practice of the invention, but not included in the claims means the claims are not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Page 2, line 21 through column 3, line 4 teach the molecular weight of the polyethylene oxide is critical to the practice of the invention and that this molecular weight is about 200,000 to about 7,000,000. This should appear in the independent claims.

Applicants' amendments to the claims did not overcome these rejections.

Claims 3-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6, 7, 9 and 11-22 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the

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elements. See MPEP § 2172.01. The omitted elements are: The molecular weight of the polyethylene oxide, which the specification indicates as critical to the invention. In claims 3-5, the preamble "The polymer method" does not correspond to the preamble of claim 1, from which claims 3-5 depend, since the method in claim 1 is not a polymer method, but a method of reducing piling. The preamble in claims 3-5 should be "The method as described in claim 1". In claim 3, the effective amount is not positively stated due to the phrase "can range". It is suggested to replace "can range" with "is". Claims 4 and 5 are indefinite and thus need to be reworded. For example, claims 4 and 5 should be as "The method as described in Claim 1 where the aqueous fountain solution has a pH in the range of about...". Claim 7 is indefinite since it is the fountain solution that the claimed claim pH, not the claimed water. Claim 6 is indefinite since part a implies the fountain solution comprises a fountain solution having a pH of about 3.2 to about 5.5. Claims 6 and 7 are indefinite as to the actual composition of the buffering system. These claims imply the buffering system is a mixture of an acid and salt, but page 3 teaches the buffering system is an acid or salt. In claim 7, it is unclear if d and g are the same or not. Finally, the amounts of d and h in claim 7 are not defined. Since the composition of the fountain solutions in claims 6 and 7 are indefinite, the dependent claims 8-22 are indefinite.

Applicants' amendments did not overcome these rejections.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 05-286279.

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This reference teaches an aqueous fountain solution comprising 10-500 ppm of a polyethylene oxide. The examples teach fountain solutions of polyethylene oxide having a molecular weight in the range of 1,700,000-2,200,000 or 4,300,00-4,800,000. While the reference does not teach the polyethylene oxide polymer is used to reduce piling, this function would be inherent in the taught fountain solution. The reference teaches the claimed method.

Claims 1 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 3,625,715.

This reference teaches an aqueous fountain solution comprising polyethylene oxide. The exemplified compositions do not contain any acidic or basic components and thus the fountain solution is a neutral solution with a pH of about 7. The reference teaches fountain solutions of polyethylene oxide having a molecular weight in the range of 50,000-150,000. While the reference does not teach the polyethylene oxide polymer is used to reduce piling, this function would be inherent in the taught fountain solution. These molecular weight range overlaps the claimed range. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re Fields* 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). The references suggest the claimed method.

Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 05-286279.

JP 05-286279 teaches fountain solutions of polyethylene oxide having a molecular weight in the range of 1,000,000-10,000,000 in an amount of 10-500 ppm. This amount falls within the claimed range and the molecular weight range overlaps the claimed range. Product

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claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re Fields* 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). While the reference does not teach the polyethylene oxide polymer is used to reduce piling, this function would be inherent in the taught fountain solution. The references suggest the claimed method.

Claims 1, 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 91,601.

This reference teaches an acidic aqueous fountain solution, having a pH in the range of about 2-5, comprising 0.005-1 wt% (50-10,000 ppm) of a polyethylene polymer. While the reference does not teach the polyethylene oxide polymer is used to reduce piling, this function would be inherent in the taught fountain solution. The molecular weight range and pH range overlap the claimed ranges. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re Fields* 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). The reference suggests the claimed method.

Applicants' arguments with respect to the above art rejections are not convincing. The fact the art did not recognize the anti-piling property of HMW-PEO does not overcome the rejections. A newly discovered property does not necessarily mean the product is unobvious, since this property may be inherent in the prior art. *In re Best* 195 USPQ 430 (CCPA 1977); *In re Swinehart* 169 USPQ 226 (CCPA 1971). There has been no showing that the claimed effect is not inherent and unexpected. The rejections are maintained.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

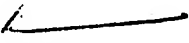
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (571) 272-1371. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached at (571) 272-1233.

The fax number for all official communications is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmk  
September 7, 2005

  
C. Melissa Koslow  
Primary Examiner  
Tech. Center 1700